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TRANSMITTAL OF APPEAL BRIEF (Small Entity)

Docket No.
MMC-10902/29

In Re Application Of: Temple

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
10/827,493	Apr. 19, 2004	B. Flanagan	25006	3739	3298

Invention: HEATER FOR SURGICAL VIEWING INSTRUMENTS

COMMISSIONER FOR PATENTS:

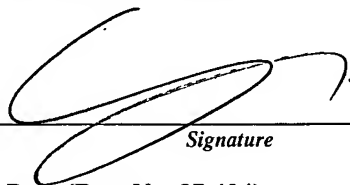
Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

☒ Applicant claims small entity status. See 37 CFR 1.27

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Signature

Dated: December 22, 2005

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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on
December 22, 2005

(Date)

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Ann K. Andrusiak

Typed or Printed Name of Person Mailing Correspondence

cc:



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Temple

Serial No.: 10/827,493

Group No.: 3739

Filed: April 19, 2004

Examiner: B. Flanagan

For: HEATER FOR SURGICAL VIEWING INSTRUMENTS

APPELLANT'S BRIEF UNDER 37 CFR §1.192

MAIL STOP APPEAL BRIEF

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Dear Sir:

I. Real Party in Interest

The real party in interest in this case is John Temple, Applicant and Appellant.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The present application was filed with 5 claims. Claim 5 was canceled by amendment. Claims 1-4 are pending in the application and claim 1 is the sole independent claim.

IV. Status of Amendments Filed Subsequent to Final Rejection

No after-final amendment has been filed.

V. Summary of Claimed Subject Matter

12/28/2005 DEPTMANU1 00000038 10827493

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This invention resides in a system for warming an endoscope, laparoscope, or other such instrument to minimize fogging. The system includes a flexible pad having a length, a width and a periphery for wrapping around the instrument (160, Figures 6 and 7). The pad includes a mixture of water and sodium acetate to generate heat through an exothermic reaction, and an activation disc (152) located around the periphery of the pad. The pad further includes one or more elongate partitions (164, 166) running lengthwise along the pad to establish fold line, each partition including a gap (168, 170) to facilitate fluid transfer of the mixture (Specification, lines 14-24).

VI. Grounds of Objection/Rejection To Be Reviewed On Appeal

- A. The rejection of Claims 1, 2 and 4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,910,106 to Morgan et al. in view of U.S. Patent No. 5,651,757 to Meckstroth.
- B. The rejection of claim 3 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,910,106 to Morgan et al. in view of US. Patent No. 5,652,757 to Meckstroth, and further in view of U.S. Patent Application Publication No. 2002/0022762 to Beane.

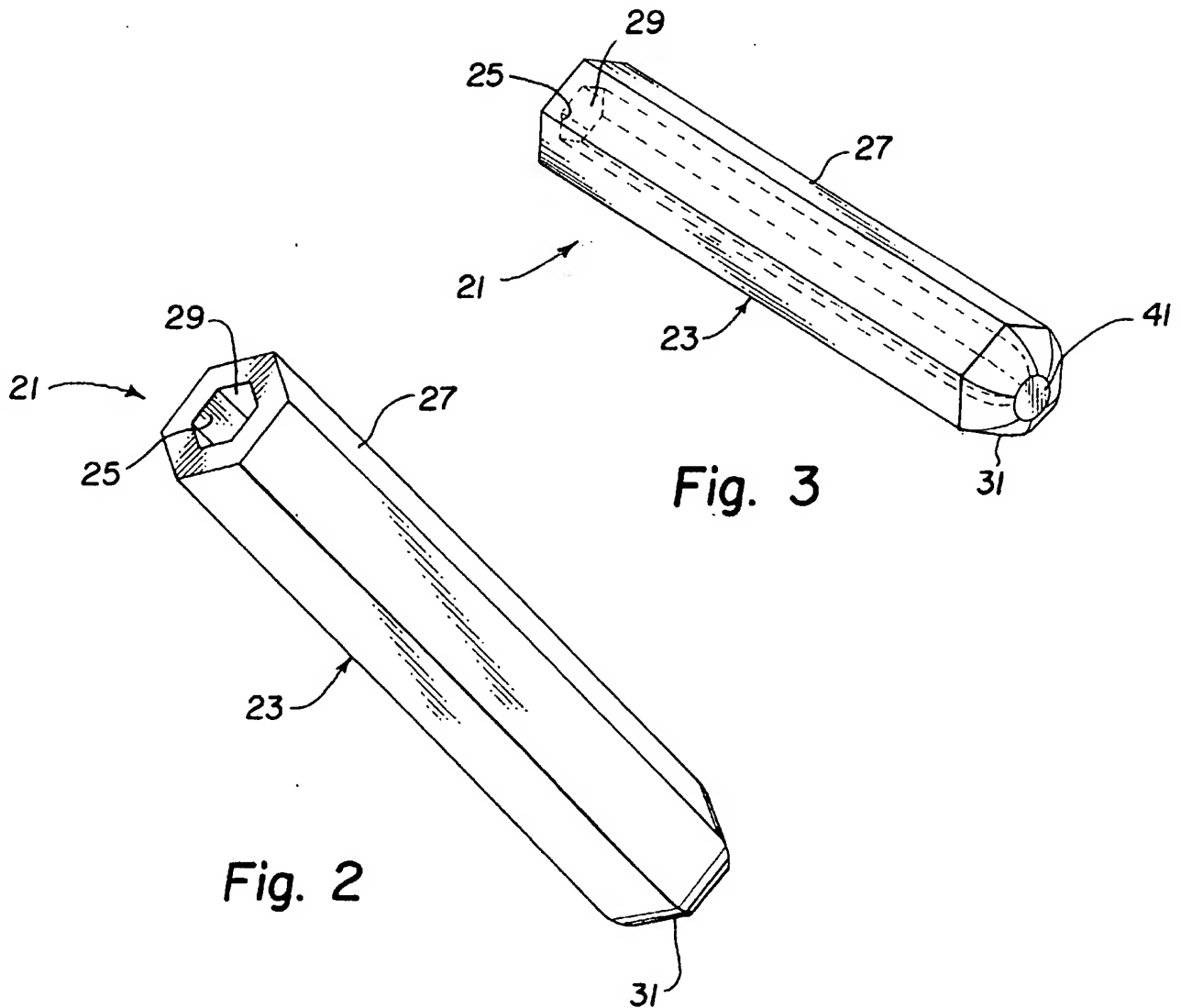
VII. Arguments

A. Rejection of Claims 1, 2 and 4 under 35 U.S.C. §103(a):

Claims 1, 2 and 4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,910,106 to Morgan et al. in view of U.S. Patent No. 5,651,757 to Meckstroth.

Morgan is directed to an instrument heater for heating a surgical instrument. "The instrument heater includes a sheath having an inner and outer wall. The inner wall forms a bore through which the optical scope is inserted. A chemical solution fills the space between the inner and outer wall of the sheath. At one end of the sheath is an activator disk having a chemical substance attached to its surface. When the activator disk is flexed, it ejects the chemical substance and interacts with the chemical solution to initiate an exothermic reaction. The exothermic reaction results in the generation of heat within the sheath, which is transmitted to the surgical instrument. Once the surgical instrument is sufficiently heated to a temperature close to the temperature of a body, the optical scope is inserted into the body." ('106 Patent, Abstract).

FIGS. 2 and 3 provide perspective views of an instrument heater 21 according to the Morgan patent, reproduced below:



"The instrument heater 21 is cylindrically-shaped. The instrument heater 21 includes a sheath 23. The sheath 23 has an inner wall 25 and an outer wall 27 running across the entire length of the sheath 23. The inner wall 25 and the outer wall 27 form an essentially circular bore (not shown in FIG. 1) through the center of the sheath 23. At one end of the sheath 23 is an opening 29 which serves as the beginning of the bore. At an opposite end of the sheath 23 is a tip 31. The tip 31 is closed-ended and essentially dome-shaped.

"The inner wall 25 and the outer wall 27 are constructed of a flexible nonporous material

allowing for the insulation of heat. In the disclosed embodiment, the material is chip board which is a thin cardboard type material which insulates the heat within the interior of the sheath 23. However, any flexible and nonporous material capable of being sterilized may be used.

“Between the inner wall 25 and the outer wall 27 is a chemical solution used in forming an exothermic reaction to create heat. In the disclosed invention, a food grade sodium acetate and water solution is utilized. Other chemical solutions may be used such as calcium chloride and water to produce the desired heat. The mixed chemical solution runs between the inner wall 25 and the outer wall 27 across the entire length of the sheath 23. Additionally, the chemical solution is present at the tip 31. The inner wall 25 and the outer wall 27 retain the chemical solution within the sheath 23.” (‘106 Patent, col. 4, lines 34 – 44).

Meckstroth, on the other hand, is directed to an endoscope warmer for preheating endoscopic surgical instruments. The warmer comprises a holster, a plurality of channels formed in the wall of the holster for circulating a heated fluid, a supply port and a return port for maintaining a constant supply of heated fluid, and a pocket defined by the holster for receiving at least the optical shaft portion of the instrument and, in the alternative, the entire instrument. The supply and return ports are sealingly attached to the holster and are adaptable for connection to heating units and pumps for circulating the heated fluid through the holster. (‘757 Patent, Abstract)

“With reference to FIGS. 1 and 2, the pad 12 may be any pad known in the art, such as the “K-pad.” The pad 12 is formed by joining two plastic, plastic-like, or similar thermal, medically safe sheets 12a and 12b along their edges 13-16 and at selected locations around its midsection. The first and second sheets 12a, 12b comprise an inner wall and outer wall which are joined by any commonly accepted practice, such as fusing, heat curing, adhesives, or other similar method.” (‘757 Patent, col. 5, lines 48 – 56)

The Examiner concedes that “[w]ith further respect to claim 1, Morgan et al. are silent as to the sheath 23 being partitioned” (Final OA, p. 3), but argues that it would be obvious to provide the sheath 23 of Morgan et al. with partitions, in the manner disclosed by Meckstroth, to more effectively circulate the chemical solution.” This reasoning is flawed.

To establish *prima facie* obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to

one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In this case, there is no suggestion or motivation to combine reference teachings, there is no expectation of success, and even if the combination were made, Appellant's invention would not result.

Since the sheath of Morgan *is not a pad*, it would *not be* obvious to provide the sheath with partitions "to more effectively circulate the chemical solution." The sheath 23 of Morgan does not lend itself to any "partitions" in any practical sense. There is no telling where they would go and there is no need to "establish fold lines." The preferred embodiment of Morgan includes an inner wall 25 and an outer wall 27 constructed of "chipboard which is a thin cardboard type material which insulates the heat within the interior of the sheath 23." (See column 4, lines 45-51). Thus, since it is already in sheath form, and constructed of a material having spaced-apart walls, there is no reason or practical implementation of "partitioning." Furthermore, although the Examiner states that this would be obvious to provide "to more effectively circulate the chemical solution," the solution is not really circulated in the sense that the fluid is circulated in the '757 patent to Meckstroth. Partitions, if somehow added to Morgan, *would get in the way*.

B. Rejection of Claim 3

Claim 3 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,910,106 to Morgan et al. in view of U.S. Patent No. 5,652,757 to Meckstroth, and further in view of U.S. Patent Application Publication No. 2002/0022762 to Beane.

The Examiner concedes that "Morgan et al. are silent as to a housing," but argues that Beane et al. demonstrate housing [sic] ... are known in the art." *But this is not the standard*. Rather, in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to combine the cited references to arrive at Applicant's claimed invention. There must be something *in the prior art* that suggests the proposed combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this

particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior-art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999). In this case, since there is no teaching or suggestion from the prior art in support of the addition of a housing to Morgan et al., *prima facie* obviousness has not been established.

VIII. Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellants seek the Board's concurrence at this time.

Respectfully submitted,

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APPENDIX A

CLAIMS ON APPEAL

1. A system for warming an endoscope, laparoscope, or other such instrument to minimize fogging, comprising:

a flexible pad having a length, a width and a periphery for wrapping around the instrument, the pad including a mixture of water and sodium acetate to generate heat through an exothermic reaction; [[and]]

an activation disc located around the periphery of the pad ~~to provide for convenient user access;~~
and

one or more elongate partitions running lengthwise along the pad to establish fold line, each partition including a gap to facilitate fluid transfer of the mixture.

2. The system of claim 1, wherein the activation disc is made of perforated stainless steel.

3. The system of claim 1, further including a housing to contain the pad in sleeve form into which the instrument is inserted.

4. The system of claim 1, further including a heat-conductive tube to receive the instrument around which the pad is wrapped.

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APPENDIX B

EVIDENCE

None.

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APPENDIX C

RELATED PROCEEDINGS

None.